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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,368	02/14/2001	Robert Michael Getler	2000-0168.00	2311
21972	7590	01/11/2005	EXAMINER	
LEXMARK INTERNATIONAL, INC. INTELLECTUAL PROPERTY LAW DEPARTMENT 740 WEST NEW CIRCLE ROAD BLDG. 082-1 LEXINGTON, KY 40550-0999			HILLERY, NATHAN	
		ART UNIT		PAPER NUMBER
		2176		
DATE MAILED: 01/11/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/783,368	GETLER ET AL.	
	Examiner: Nathan Hillary	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 August 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-15 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 8/23/04.
2. Claims 1 – 15 are pending in the case. Claims 1, 6, and 12 are independent.
3. The rejection of claims 1 – 5 under 35 U.S.C. 112, second paragraph as being indefinite has been maintained.
4. The rejection of claims 1 – 15 under 35 U.S.C. 103(a) as being unpatentable has been maintained.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 1 – 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. **Regarding independent claim 1**, it is unclear what applicant means by "satellite". Consequently, all subsequent recitations of "satellite" are also rejected.
8. **Regarding dependent claims 2 – 5**, the claims are rejected for fully incorporating the deficiencies of the base claim(s) from which they depend.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1 – 5 and 12 – 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rourke et al. (US005995721A) [as cited by applicant].

11. **Regarding independent claim 1**, Rourke et al. teach that *clients provide the electronic documents that are the source of the print jobs and for this purpose individual ones or all of clients may have a document scanner, disk input, keyboard, fax, etc. for generating the electronic documents that comprise the job to be printed* (Column 7, lines 2 – 7), which provide for **a plurality of input sources; a plurality of satellite servers connected to said input sources, said satellite servers being configured to receive a plurality of digital files from said input sources**. Rourke et al. also teach that *system provides print processing for various workstations or clients. Clients, which may be remote and/or on site, are operatively coupled to printers through server* (Column 6, line 60 – 64), which provide for **a central server connected to said satellite servers, said central server being configured to receive said digital files from said satellite servers and perform at least one action on at least one of said digital files**. Although, Rourke et al. do not explicitly teach **satellite servers or a central server**, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to interpret and/or employ a central server in conjunction with Rourke et al. since Fig 1 illustrates one main server (**central server**) to which the clients must connect in order to fulfill their print job requests. As for the **satellite servers**, the *clients* mentioned in the teachings of Rourke et al. can be interpreted as such servers, since it is well-known that servers can function as clients and clients as servers.

12. **Regarding dependent claim 2**, Rourke et al., in his discussion of prior art points out that *the advantage of using one or more queues in a printing process has been demonstrated ... [the prior art] discloses a system in which copy/print jobs are delivered to an output queue which communicates with a printer while Fax jobs are delivered to a hold queue which communicates with the output queue. In practice, after a certain number of Fax jobs have accumulated in the hold queue, they are delivered to the output queue in such a manner that the Fax jobs are printed ahead of all jobs currently residing in the output queue* (Column 3, lines 22 – 32), which provide for **said satellite servers are configured to store accumulated jobs**.

13. **Regarding dependent claim 3**, Rourke et al. do not explicitly teach **off-peak time period**. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret the invention of Rourke et al. as providing for **said satellite servers are configured to pass the accumulated jobs to said central server during at least one off-peak time period**, since Rourke et al. do teach that *while only one server and a limited number of document processing apparatuses are shown in FIG. 1, the preferred embodiment contemplates the use of as many servers and document processing units as required to meet the demands of the users of the system* (Column 6, line 65 – Column 7, line 2). The skilled artisan can interpret that the invention of Rourke et al. would only need to employ the one server during an off-peak time period, since the demands of the users would be extremely low.

14. **Regarding dependent claim 4**, Rourke et al. teach that *individual ones or all of clients may have a document scanner, disk input, keyboard, fax, etc.* (Column 7, lines 4

– 6), which provides for **said input sources include at least one of a scanner and a personal computer.**

15. **Regarding dependent claim 5**, Rourke et al. teach that *in one example, electronic document(s), which includes image and attribute related information, is transmitted from the client to the server* (Column 7, lines 29 – 31), which provide for **at least one said digital file comprises an electronic image.**

16. **Regarding independent claim 12 and dependent claim 13**, the claims incorporate substantially similar subject matter as claim 1, and are rejected along the same rationale.

17. **Regarding dependent claim 14**, the claim incorporates substantially similar subject matter as claim 4, and is rejected along the same rationale.

18. **Regarding dependent claim 15**, Rourke et al. illustrate in Fig. 1 (15-N) **an administrative client for at least one of configuring and monitoring said server.**

19. Claims 6 – 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Senn et al. (US006151610A).

20. **Regarding independent claim 6**, Senn et al. teach that *any paper document can be entered into the system by scanning* (Column 3, lines 66 – 67), which provides for **scanning a document with a scanner to thereby obtain the digital file**. Senn et al. also teach *a document management apparatus has a scripting language which controls documents by setting the attributes of documents. Attributes are pieces of data within a document. A script engine reads a script from a cache memory and launches*

the processes to accomplish the desired action of the script (Column 1, lines 33 – 40).

Senn et al. do not explicitly teach **job object** or **action object**. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the invention of Senn et al. to provide for **building a job object including a plurality of action objects; and performing the action objects on the digital file**, since the skilled artisan would interpret *setting the attributes of a document* as a **job object** and *the processes to accomplish it as a plurality of action objects*.

21. **Regarding dependent claim 7**, Senn et al. teach that as an alternative, an *identifier process can be designed and used to determine whether the value of an attribute is script, and also what script interpreter is needed to interpret it. The identifier process does not test whether the script can be properly parsed, but upon determining that the value of an attribute is script, chooses which script interpreter to call to interpret the script* (Column 3, lines 19 – 25), which provide that **said building step is performed by a parser**.

22. **Regarding dependent claim 8**, Senn et al. teach that *upon determining that the value of an attribute is script, chooses which script interpreter to call to interpret the script. For example, the identifier process can select an interpreter for a dialect of the LISP programming language by checking the first non-whitespace character to see if it is a left parenthesis or single-quote. If the first non-whitespace character is a left parenthesis of a single-quote, the identifier process selects the interpreter for the dialect of the LISP programming language to interpret the script* (Column 3, lines 24 – 31),

which provides that **said building step is dependent upon a plurality of script settings.**

23. **Regarding dependent claim 9**, Senn et al. teach that *the expression, dump "concatenate" & "these" & "strings" prints "concatenate these strings" to the computer display device* (Column 33, lines 58 – 61), which provide that **said action objects include at least one of printing, emailing and faxing.**

24. **Regarding dependent claim 10**, Senn et al. teach that *locals are containers that exist only for the duration of a thread of execution and are local to that thread. Since threads often execute in parallel in the scripting language, it is usually appropriate to use locals to store temporary results within a thread* (Column 33, lines 10 – 14), which provide that **said performing step includes assigning said action objects to individual worker threads.**

25. **Regarding dependent claim 11**, Senn et al. teach that *each client module may then access the repositories 142 to retrieve those permanent attributes, convert the permanent attributes to ephemeral attributes, and update the local display* (Column 20, lines 64 – 67), which provide that **said performing step includes requesting at least one action module.**

Response to Arguments

26. Applicant's arguments filed 8/23/04 have been fully considered but they are not persuasive.

27. In response to Applicant's arguments that the term satellite is a definite term in light of the specification (p 2 – 3), it should be noted that "satellite" within the context of

“satellite server” has multiple established meanings that make it difficult for the Office to discern the metes and bounds of such a term without further explanation, i.e. satellite servers can be servers that are located remotely or servers that communicate over a satellite network. The specification does not even provide adequate differentiation between the two aforementioned examples, which is not an exhaustive list of possibilities on which the term “satellite servers” can be read.

28. In response to Applicant’s arguments regarding Netlingo (p 3 – 7), it should be noted that Netlingo was used simply as a dictionary to provide proof of a concept that was well-known within the art at the time of the invention. For purposes of compact prosecution, the reference has been withdrawn, since the Office believes that it does not need to rely on the dictionary for such a notoriously well-known concept.

Furthermore, the definition provided by Netlingo was that of client/server architecture; the specific citation was describing computers within a client/server model. The Office realizes that a client and server perform different functions; however, the Office’s argument is that the same computer can perform all of the functions of both a server and a client depending on what is asked or expected of the computer at a certain time.

29. In response to Applicant’s argument that Rourke et al. do not teach satellite servers or central server (p 5 and 6), it should be noted that the Office used a broad interpretation of “satellite servers” due to the indefiniteness of the term “satellite” within the context of the claimed invention in light of the specification. Consequently, the Office did not fully consider the term “satellite”, since it could not discern a definitive meaning for it; although, the Office did interpret the term “satellite server” to be the “remote

clients" taught by Rourke et al. based on the functions of the "satellite servers" as outlined in the claimed invention in light of the specification. Also, the Office reiterates that Rourke et al. did not explicitly teach "central server"; however, Rourke et al. does teach a *main server*, which those of ordinary skill in the art at time of the invention would understand is synonymous with a "central server".

30. In response to Applicant's argument that Rourke et al. do not teach off peak time period (p 8), it should be noted that the term off peak time period has a well established meaning within the art. Furthermore, the invention of Rourke et al. adjusts its work load to accommodate high demand situations, e.g. high or on peak time period, by imploring more servers to meet users' demands; therefore, the invention of Rourke et al. will always provide the requests for its users regardless of the time that they are made.

31. In response to Applicant's argument that Rourke et al. do not disclose a server... (p 9), it should be noted that Rourke et al. teach that *each of printers 12-1, 12-2, 12-3, 12-n may be any suitable printer capable of producing prints on a print media such as paper from video image signals and may, for example, comprise laser printers, ink jet printers, digital copiers, highlight or full process color printers, ionographic printers, combinations of the aforesaid devices, etc. In system 10, where multiple printers are integrated into a network processing system, individual printers typically have different document processing capabilities as will appear* (Column 6, lines 48 – 57). The Office's argument is that even the simple act of printing by the server involves a plurality of operations to be performed on a file as indicated by the teachings of Rourke et al. Further, the limitation(s) indicated in claim 12 are broad in comparison to claim 1, and

since broad can always be rejected using narrower subject matter, claim 12 was rejected with the same rationale as claim 1.

32. In response to Applicant's argument that Senn et al. do not teach a job object or an action object (p 10 and 11), it should be noted that Senn et al. may not explicitly teach a job object or an action object. However, it is the assertion of the Office that one of ordinary skill in the art at the time of the invention would be motivated to implement and/or use Senn et al. to provide for a job object or action objects, since setting attributes of a document is a job that is performed by the system using a scripting language; it involves many processes to accomplish it, which is performed by a plurality of action objects. The Office's motivation comes from the fact that the skilled artisan is well aware of the concept of a job ticket to which the benefit of grouping attributes and directions or scripts into a single object is analogous.

33. In response to applicant's argument that **the prior art must suggest the desirability of the claimed invention** (p 11, line 13), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

34. In response to Applicant's argument that Senn et al. does not teach a parser (p 12), it should be noted that the Office interprets "the script interpreter" disclosed by Senn et al. as a parser. The Office understands that the Applicant may not mean the

broad interpretation used in the rejection; however, the broad interpretation still falls within the scope of the invention as claimed.

35. In response to Applicant's argument that Senn et al. do not teach individual worker threads (p 13), it should be noted that the Office interprets "locals" as action objects and "a thread of execution" as an individual worker thread. The Office realizes that the Applicant may not mean the broad interpretation used in the rejection; however, the broad interpretation still falls within the scope of the invention as claimed, especially considering the use of such broad terms to describe the claimed invention.

Conclusion

36. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER

NH